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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,596	08/16/2001	Nigel John Middleton	27020/37460	6505

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

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DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,596

Applicant(s)

MIDDLETON, NIGEL JOHN

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 4, 6, 7, 10, 22, 25 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "adapted to be disposed at least intermittently in use between" in claim 1 is unclear, which renders the claim vague and indefinite. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to do perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

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The phrases “there is further” and “both of these” in claim 1 is unclear, which renders the claim vague and indefinite. The third person language is unclear and needs to be changed to clearly claim the invention.

The phrase “part of a person or animal” in claims 1, 20 and 22 is unclear, which renders the claim vague and indefinite. A part of a living being cannot be claimed as part of the invention, as the applicant did not invent it.

The phrase “there is further” in claim 22 is unclear, which renders the claim vague and indefinite. The third person language is unclear and needs to be changed to clearly claim the invention.

The phrases “adapted to be disposed at least intermittently in use between, to the first side, a part of a person or animal and, to the second side, a surface”, “for spacing the sheet from the said part of the person or animal, from the said surface, or from both of these” and “in use between both the surface and the part of a person or animal the article is breathable to restrict discomfort to the person or animal” in claims 1 and 22 is unclear, which render the claims vague and indefinite. It has been held that recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

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The phrases “for spacing the sheet from the said surface” in claim 2, “for spacing the sheet from the person or animal” in claim 4, “so that the article conforms in use to the shape of the person or animal or the surface” in claim 6, “have a sufficient resilience that the perforations of the sheet remain open during normal use and the second side of the article is not normally pressed against the surface” in claim 7 and “for spacing the sheet from the person or animal” in claim 25 is unclear, which render the claims vague and indefinite. It has been held that recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

4. The term "substantially impermeable material" in claim 1 is a relative term which renders the claim indefinite. The term "substantially impermeable material" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

5. The terms "substantially the same" in claims 6 and 22 and “substantially all” in claims 10 and 30 are relative terms which renders the claim indefinite. The term "substantially the same" and “substantially all” are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Correction/clarification is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4, 6, 7, 15 – 23, 25, 27 and 30, 35 – 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Middleton (WO 91/12958).

Middleton discloses a breathable fabric formed from a sheet of impermeable material (Page 4, lines 14 – 19) with perforations in the material (Page 4, line 20 to Page 5, line 6) that is worn next to the skin of the user (Page 8, line 29 to Page 9, line 3). Projections, spacer members, of the same height due to the same size of perforations (Page 12, lines 29 – 32) are formed on the surfaces of the fabric (Page 11, lines 18 – 23 and Figure 2a, #8). The projections are of a resilient material which allows the perforations to remain open during the use of the article (Page 10, lines 5 – 13 and Page 17, lines 1 – 7). Chambers are formed in the material by the layers of materials and perforations, where the perforations are arranged to allow air to flow from surface of the sheet to the other by increased pressure (Page 2, lines 10 – 21). At the location of each perforation, a dome surrounds the outer surface (Page 11, lines 18 – 23 and Figure 2a). The formed sheet is used for a variety of different articles including different types of clothing, orthopedic supports, liners for casts and medical or veterinary dressings (Page 14, line 9 to Page

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15, line 13). The layers are adhered on their surfaces by permanent adhesives (Page 10, lines 14 – 18).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 5, 8 – 14, 24, 26, 28, 29 and 31 – 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Middleton.

Middleton discloses the claimed breathable article made from a laminate of materials, where the laminate includes woven, water-absorbent material (Page 4, lines 7 – 10) and vapor-permeable materials (Page 6, line 20 to Page 7, line 8) above except for the spacer members projection from only the first or only the second major surface, the spacer members being discontinuous, the spacer members being continuous, the continuous spacer member extending across substantially all of at least one side of the sheet and the spacer members comprising a network of ribs on the respective side or sides of the sheet.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) Also,

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see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape and location of the spacer members to make the continuous, discontinuous or in the shape of ribs. One skilled in the art would have been motivated to do so in order to separate the skin of the user from the fecal material deposited in the article.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Nos. 5,733,626, 5,620,771 and 5,656,352 to Middleton are cited to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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pln

December 10, 2002

[Signature]
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

12/10/02